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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,232	08/03/2001	Samuel Sergio Tenenbaum	2875/1G342-US1	7566

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DARBY & DARBY P.C.
805 Third Avenue
New York, NY 10022

EXAMINER	
CARLSON, JEFFREY D	
ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PN

Office Action Summary	Application No.	Applicant(s)	
	09/922,232	TENENBAUM, SAMUEL SERGIO	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 September 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-52 and 58-66* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-52 and 58-66* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the paper(s) filed 9/22/04.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9, 21, 23-28, 34-40, 46, 48-52, 58-66 are rejected under 35 U.S.C. 102(b) as being anticipated by Gever et al (WO 97/35280).

Regarding claims 1-5, 9, 23-27, 34-36, 40, 48, 49, 58, 59, 63-66, Gever et al (WO 97/35280) teaches the steps, system and programming to provide an animated character travel (translationally) across the user's screen in the form of an advertisement [abstract, 4:5-11, 7:1-15, 32:29-3136:11-13, figs 2, 6A]. The character is provided intrusively, out of the user's control as a transparent layer on top of the background content (such as a web page in an HTML-compliant browser). The area not covered by the character layer is visible through the transparency mask. Gever et al (WO 97/35280) teaches that the character may include audio such as reading displayed text (synchronized sound) – such is taken to provide a multimedia character [7:8-10]. Applicant's preamble and other language that mentions the environment of the operating system, computer system, application program and language, etc does not positively provide steps to be taken or system structure and therefore these are not

taken as limitations, but rather functional language. The environment in which a series of steps are performed does not define the steps themselves, for example. Further regarding claim 9, Gever et al (WO 97/35280) teaches that the animation files can be provided as VMRL, JAVA or HTML [10: 1-5].

Regarding claims 6-8, 28, 37-39, 46, 50-52, 60-62, Gever et al (WO 97/35280) teaches that the characters are defined as smart objects which are defined by parameters that determine their behavior; such stored parameters are taken to be stored in a server-accessible database [5:29-37, 6:1-17]. The client's PC communicates with the server in order to request and negotiate/authorize display of the animations. This communication is taken to meet the "exchange of information" language. The client PC inherently cannot display/control the animation if the PC lacks a minimum of video display capabilities, for example. The communication/exchange is taken to be interactive and results in determination of a sequence of commands to deliver that control the animation aspects.

Regarding claim 21, Gever et al (WO 97/35280) teaches that a sender may deliver an email message with an animation file included [10:23-27]. The animation files define the character behavior. The server signal which will call a page language does not provide any positive steps beyond a signal. Steps for calling of a page and displaying after completion of the message are not set forth positively. Nonetheless, the server which delivers the email inherently defines a background in the case of an HTML-based email message which remains until the user closes the message.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 10-12, 14-20, 29-33, 41-45, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al (WO 97/35280) in view of Gever et al (US6313835).

Regarding claims 10, 12, 14-18, 29-32, 41-45, Gever et al (US6313835) teaches that such animations can be programmed by an advertiser and triggered to display upon the user visiting a particular webpage. An animation ad is then chosen for the user based upon the user's profile and delivered and displayed for the user in his browser. It would have been obvious to one of ordinary skill at the time of the invention to have provided tags in particular webpages that enabled the system to recognize an advertising opportunity and to trigger the selection, delivery and display of the animation advertising character. The example of a user browsing Yahoo [WO fig 6A] while receiving an animation provides an example of content from a content server and animation from the system server of Gever et al (WO 97/35280).

Regarding claims 11, 33, Gever et al Gever et al (WO 97/35280) teaches that the animation display capability can be provided as part of a browser plug-in. It would have been obvious to one of ordinary skill at the time of the invention to have delivered the

animation file as well as the plug-in installation file so the user can view the animation upon installation of the plug-in.

Regarding claims 19, 20, 47, Official Notice is taken that it is well known to use cookies to track and deliver user profile information, browsing history and preferences, etc and it would have been obvious to one of ordinary skill at the time of the invention to have used such cookies to target the animation selection and control of Gever et al (WO 97/35280).

6. **Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al (WO 97/35280) in view of Gever et al (US6313835) and Middleton et al (WO 99/13423).** Middleton et al teaches tracking the effectiveness of web advertising in terms of the number of impressions and the duration of ad display. It would have been obvious to one of ordinary skill at the time of the invention to have tracked such information and paid the advertiser provider (i.e. Gever's character server) accordingly so that the advertiser pays more for the effectiveness of the advertising.

7. **Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al (WO 97/35280) in view of Middleton et al (WO 99/13423).** Middleton et al teaches tracking the effectiveness of web advertising in terms of the number of impressions and the duration of ad display. It would have been obvious to one of ordinary skill at the time of the invention to have tracked such information and paid the

advertiser provider (i.e. Gever's character server) accordingly so that the advertiser pays more for the effectiveness of the advertising.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc